

REMARKS**Summary**

Claims 1-37 are pending.

Rejections Under 35 USC 102

Claims 1-5, 7, 13-17, 19, 22-24, 26, 29-31, 34, and 36 are rejected under 35 USC 102(e) as being unpatentable over US Patent Application Publication No. 2004/0254893 to Tsuei et al. (Tsuei). In light of the remarks below, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claim 1 recites, *in an electronic delivery address service, a method comprising: receiving by the delivery address service via electronic communication, an electronic subscription from a subscriber, the received subscription including a mailing address of the subscriber,*

in response, the delivery address service electronically generating a substitute delivery address;

transmitting by the delivery address service via electronic communication the substitute delivery address to the subscriber, for the subscriber to use in an online purchase of a good;

receiving by the delivery address service via electronic communication, an electronic notification of either a request to deliver or an arrival of the purchased good, as a result of the substitute delivery address being used by the subscriber in the online purchase of the good; and

intervening by the delivery address service by electronically accessing and communicating the mailing address provided by the subscriber as part of said electronic subscription to a delivery service to facilitate delivery of the purchased good to the subscriber at the mailing address of the subscriber, wherein said mailing address accessed and communicated by said delivery address service is retrieved from a database of said delivery address service.

As is clearly shown in claim 1, control over the provision, storage, access, and retrieval of the subscriber's provided mailing address resides with the delivery address

service. The mailing address is provided by the subscriber during a subscription process. In response, a substitute delivery address is provided by the delivery address service. After the substitute delivery address is utilized by the subscriber, the delivery address service is notified and then intervenes in the process to provide the mailing address. Thus, it is the same party that provides each of these services.

In summary, claim 1 provides a delivery address service that (1) provides a substitute delivery address to a subscriber, (2) stores the mailing address provided by the subscriber during the subscription process, (3) stores and accesses the mailing address of the subscriber in its own database, (4) receives an electronic notification of a request to deliver or an arrival of the good, and (5) intervenes in the shipping process to provide the mailing address of the subscriber to the delivery service.

In contrast, the methods of Tsuei provide an anonymous shipping address utilizing a private mailing code, which is defined as a unique character string (which is NOT an address). In such a method, the private mailing code obfuscates the true delivery address from an unauthorized party using a code. In Tsuei, when a delivery is passed from a merchant to a shipper, the shipper must then contact the PMMC to request and obtain the true address useable for shipping purposes. Further, the shipper in Tsuei is provided with access to the private mail database to look up the true address of the purchaser (see Paragraphs 242 and 246). Note that it is the shipper (not the delivery address service) who takes the action to access, retrieve, and map the shipping code to a useable shipping address.

The Office Action points to Paragraph 29 of Tsuei as teaching the use of a substitute address, but rather simply discloses that the shipper may readdress or relabel a delivery (designated by a non-address shipping code) with the true useable delivery address. That theme is repeated throughout Tsuei, as it is the shipper's relationship with the PMMC that allows it to access the PMMC database and look up the delivery address mapped to the private mailing code. Thus, claim 1 is distinguished, in part, based on the fact that the true delivery address is "pushed" to the shipper by the delivery address service, whereas, in Tsuei, the true delivery address is "pulled" from the database by the shipper.

Claim 1 specifically recites that the delivery address service receives notification of a request to deliver or the arrival of the good, and then intervenes to provide the true mailing address to the shipper. In claim 1, the shipper does not request the true address, but because the delivery address service intervenes, the shipper is provided with the true delivery address. That operation of claim 1 allows for the shipper to remain unaware of the system until the delivery address service intervenes and provides the delivery address.

Contrarily, the methods of Tsuei provide that the shipper is a partner in the system that requests the true delivery address when needed. In an embodiment as described in Paragraph 232 of Tsuei, a warehouse may be used as an alias address, but the readdressing of any such deliveries is still accomplished as a result of a request to the offline database to retrieve the true delivery address. Tsuei does not provide for the receipt of notice by a delivery address service, nor for the intervention by the delivery address service to provide the true delivery address to a delivery service.

The claimed delivery address service is thus transparent to the merchant and shipper, etc. because it utilizes a substitute delivery address that does not alert the merchant or the shipper to its use and does not require the merchant or the shipper to decode the address or to request a true delivery address be provided.

Thus, Tsuei fails to teach all the elements of claim 1 and, therefore, claim 1 is patentable over Tsuei.

Independent claims 15, 22, and 29 include in substance the same recitations as described for claim 1. Thus, for at least the above stated reasons, claims 15, 22, and 29 are patentable over Tsuei.

Claims 2-5, 7, 13-14, 16-17, 19, 23-24, 26, 30-31, 34, and 36 depend, directly or indirectly, from either claim 1, 15, 22, or 29, incorporating their limitations. Therefore, for at least the same reasons discussed above, claims 2-5, 7, 13-14, 16-17, 19, 23-24, 26, 30-31, 34, and 36 are patentable over Tsuei.

Rejections Under 35 USC 103

Claims 6, 8-10, 12, 18, 20-21, 25, 27-28, 32-33, 35, and 37 are rejected under 35 USC 103(a) as being unpatentable over Tsuei in view of US Patent No. 6,336,100 to

Yamada (Yamada). In light of the remarks below, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Yamada fails to overcome the deficiencies of Tsuei discussed above. Thus, in light of the arguments with respect to claims 1, 15, 22, and 29, Applicant respectfully requests withdrawal of the rejection.

Therefore, based at least in part on their dependencies on claims 1, 15, 22, and 29, directly or indirectly, Applicant submits that claims 6, 8-10, 12, 18, 20-21, 25, 27-28, 32-33, 35, and 37 are patentable over Tsuei and Yamada, whether alone or in combination.

Furthermore, the express teachings of Yamada teach away from its combination with Tsuei. Yamada teaches the discrimination of members of the shopping service by the provision of information to a merchant. That information can include an alternative location to which a good may be shipped. However, at all times the purchaser is known by the merchant and the shippers within the chain.

The present claims clearly maintain the anonymity of the user. The mailboxes merely provide a defined physical location that comprises the substitute delivery address. That address is determined by the electronic delivery address service, and is further transparent to the merchant/shipper.

Therefore, as stated above, claims 6, 8-10, 12, 18, 20-21, 25, 27-28, 32-33, 35, and 37 are patentable over Tsuei and Yamada, whether alone or in combination.

Rejection Under 35 U.S.C. § 103(a) over Tsuei, Yamada, and Ohkada

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuei and Yamada in view of U.S. Patent Application Publication No. 2002/0022967 to Ohkada (Ohkada).

Ohkada fails to overcome the deficiencies of Tsuei and Yamada discussed above. Thus, in light of the arguments with respect to claims 1, 15, 22, and 29, Applicant respectfully requests withdrawal of the rejection.

Therefore, based at least in part on its dependency on claim 1, Applicant submits that claim 11 is patentable over Tsuei, Yamada, and Ohkada, whether alone or in combination.

Furthermore, the express teachings of Yamada teach away from its combination with Tsuei and Ohkada. Yamada teaches the discrimination of members of the shopping service by the provision of information to a merchant. That information can include an alternative location to which a good may be shipped. However, at all times the purchaser is known by the merchant and the shippers within the chain.

The present claims clearly maintain the anonymity of the user. The mailboxes merely provide a defined physical location that comprises the substitute delivery address. That address is determined by the electronic delivery address service, and is further transparent to the merchant/shipper.

Therefore, as stated above, claim 11 is patentable over Tsuei, Yamada, and Ohkada, whether alone or in combination.

CONCLUSION

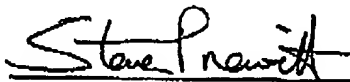
In light of the above remarks, Applicant submits claims 1-37 are in condition of allowance. Early issuance of Notice of Allowance is respectfully requested.

The Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

Respectfully submitted,

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